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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,601	10/06/2000	Bayard S. Webb	0112300/142	9574

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EXAMINER

ASHBURN, STEVEN L

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 08/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/680,601

Applicant(s)

WEBB ET AL.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,6.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Examiner's Affidavit (1 page)*


MARK SAGER
PRIMARY EXAMINER

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DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature of repeating a bonus game segment if a player chooses a predetermined maximum number of allowed selector associated with high value awards (*claim 9*) must be shown or the feature canceled from the claims. No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose repeating a bonus game segment if a player chooses a predetermined maximum number of allowed selector associated with high value awards.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple

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assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-12, 18 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-34 of copending Application No. 09/689/510. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim equivalent methods for revealing unselected hidden selections in a gaming device. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-9, 14, 16, 22 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by *Yoseloff*, U.S. Patent 6,312,334 B1 (Nov. 6, 2001).

Yoseloff discloses a multi-stage gaming system in which a player optionally risks an award to participate in a subsequent game segment. The reference teaches the following features of the claimed subject matter:

- a. Providing an initial sequence that includes at least one player decision, said decision resulting in a successful outcome or an unsuccessful outcome for a player. *See fig. 1, 2; col. 3:19-4:20, 5:20-33. (Claim 1)*
- b. Enabling a player to input a decision into a processor of a gaming device. *See fig. 1, 2; col. 5:34-6:44. (Claim 1)*
- c. Enabling a player to input into a processor a decision to keep a currently held award or to input a decision to risk losing the held award to try for a higher value award and wherein the decision can produce a successful outcome or an unsuccessful outcome. *See id.*
- d. Determining if the decision produces a successful or unsuccessful outcome in the sequence. *See id. (Claims 1, 14)*
- e. Providing an award to the player if the decision produces a successful outcome. *See id. (Claim 1)*

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- f. Enabling the player to advance to a further sequence of the gaming device wherein the sequence utilizes the award. *See id.* (Claim 1)
- g. Ending the sequence if the player inputs a decision to keep the currently held award. *See id.* (Claim 14)
- h. Ending the sequence if an unsuccessful outcome occurs. *See id.* (Claim 15)
- i. Replacing the currently held award with a lower value award if an unsuccessful outcome occurs. *See id.* (Claim 16)
- j. Replacing the currently held award with a lower value award and ending the sequence if an unsuccessful outcome occurs. *See id.* (Claim 17)
- k. Replacing the currently held award with the higher value award if the successful outcome occurs. *See id.* (Claim 22)
- l. Selecting on of a plurality of initial sequences to provide a player. *See* 3:2-18, 6:25-27. (Claim 2)
- m. Providing a consolation award to a player if the decision produces an unsuccessful outcome. *See col.* 6:6-17. (Claim 3)
- n. Consolation award includes the unsuccessful outcome. *See id.* (Claim 4)
- o. Associating a high value award with either a first selector or second selector, wherein the high value award is greater than a currently held award. *See fig.* 7; *col.* 2:12-28, 6:25-32, 7:19-34. (Claim5)
- p. Associating a low value award with the selector not associated with the high value award, wherein the low value award is less than the player award *See id.* (Claim5)
- q. Enabling the player to keep the player award, choose the first selector, or choose the second selector. *See fig.* 1, 2, 7; 6:1-44. (Claim5)

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- r. Providing the player award to the player if the player keeps the player award.
See id.
- s. Providing the low value award to the player if the player chooses the selector associated with the low value award. *See id. (Claim 5)*
- t. Providing the high value award to the player if the player chooses the selector associated with the high value award. *See id. (Claim 5)*
- u. Repeating the game segment if the player chooses a selector associated with the high value award. *See id. (Claim 6)*
- v. Repeating the game segment if the player chooses a selector associated with the successful outcome. *See id. (Claim 23)*
- w. Repeating the game segment if the player chooses a selector associated with the high value award, whereby the high value award is used to determine the currently held award while repeating the segment. *See id. (Claim 7)*
- x. Repeating the game segment if the player chooses a selector associated with the successful outcome, whereby the successful outcome is used to determine the currently held award while repeating the segment. *See id. (Claim 7)*
- y. Repeating the game segment if the player chooses a predetermined number of selections associated with high value awards. *See id. (Claim 9)*

Thus, the claimed subject matter is unpatentable because *Yoseloff* teaches every feature.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 13 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Yoseloff*, in view of *Vancura*, U.S. Patent 6,398,218 (Jun. 4, 2002).

The gaming system taught by *Yoseloff* describes all the features of the instant claims except (a) ending the bonus sequence if the player chooses a selector associated with a highest award value in a sequence (*claims 8, 25*) and (b) offering selections with at least two selections with high values and two selections with low values (*claim 13*). Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan in view of *Vancura*.

In regards to claims 8 and 25, *Vancura* discloses an analogous gaming system providing extended bonus games. The reference describes various methods for controlling a bonus game's length and player involvement. *See col. 2:64-67*. In one variation, the bonus sequence ends when a player's winnings equals or exceeds a predetermined value in order to protect operators against paying unexpectedly large awards. *See col. 4:12-16*. In another variation, when a player competes a predetermined number of bonus attempts is paid a jackpot to terminate the bonus round. *See col. 4:27-35*. Thus, *Vancura* suggests terminating a bonus sequence upon award of a large payout to control the length and expected value of a bonus game. In view of *Vancura*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the multi-segment bonus game taught by *Yoseloff*, wherein a player continues to make selections until choosing a non-winning selection, to add the feature of ending the bonus sequence if the player chooses a selector associated with a highest award value in a sequence. As suggested by *Vancura*, the modification would protect operators by controlling a bonus game's length and payout while maintaining player involvement.

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In regards to claim 13, *Vancura* discloses a bonus game with three selections. *See fig. 1; col. 12:47-54*. Alternatively, the reference suggests that any number of outcome selections could be used. *See id.* As is notoriously known in the art, modifying the number of possible outcomes modifies the odds of the game. Thus, in view of *Vancura*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Yoseloff*, wherein game outcomes include a high and low selection outcomes, to add the feature of offering selections with at least two selections with high values and two selections with low values to modify the odds of selecting a successful outcome and thereby control the games expected payout. Furthermore, it would be obvious to an artisan to increase the number of selections without modifying the odds merely to change to appearance of the game.

Claims 10-12, 18-21 and 24-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Yoseloff*, in view of Schwartz, et al., *The Encyclopedia of TV Game Shows*, 3rd Ed., Checkmark Books (1999) (hereinafter "*Encyclopedia*").

Yoseloff discloses a gaming system that entices players to risk an initial award in return for the opportunity to receive greater payoff in a second game segment in which players chooses from several hidden awards. The reference suggests basing the game's theme on popular game shows such as LET'S MAKE A DEAL[®], THE PRICE IS RIGHT[®], WHEEL OF FORTUNE[®], JEOPARDY![®], HOLLYWOOD SQUARES[®], or any game having the visual appearance of a game shows with a host, audience, participants, etc. *See col. 763-9:8*. In one embodiment, *Yoseloff* describes the LET'S MAKE A DEAL[®] game wherein players risk a prize in return for a masked prize behind one of three doors, as in the live television game show. *See fig. 6, 7; col. 7:18-33*. Furthermore, *Yoseloff* suggests maintaining "thematic continuity" between the gaming device and the television game show upon which it is based. *See col. 7:48-63*. In specific regards to the invention, *Yoseloff* also describes the following features of the instant claims:

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- a. Repeating the sequence of bonus segments and each increasing the award each time. *See col. 6:1-43. (Claim 27)*
- b. Repeating the sequence of bonus segments a random number of times and each increasing the award each time. *See id. (Claim 28)* Notably, the number of segments is randomly determined by the player's random chance of selecting a successful outcome which allows the bonus sequence to continue.

Hence, as describe above, *Yoseloff* teaches all the features of the claimed subject matter except the following:

- a. Revealing unselected selections. *(Claims 10-12, 18, 19)*
- b. Performing a tease sequence if the player inputs a decision to play for a higher award or an unsuccessful outcome occurs. *(Claims 20, 21)*
- c. Performing a tease sequence without revealing the determination of the player's success, wherein the player is enabled to input a decision to keep an increased award and ending the tease sequence if the player decides to keep the award. *(Claim 24)*

Regardless of the deficiencies, these features would have been obvious to an artisan in view of *Encyclopedia*.

Encyclopedia describes the popular television game show LET'S MAKE A DEAL® which aired and various broadcast networks between 1963 and 1991. The game allows contestants to earn awards and optionally swap them for several other hidden awards. *See p. 125.* The hidden awards range in value from items of high value (e.g. cash or merchandise) to consolation prizes of little value. *See id.* Consolation prizes where frequently revealed by the show's announcer in an entertaining presentation. *See id.* As a result, contestants who opted to swap awards took the risk of receiving a item of value for one of little value.

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The following facts about the process of revealing awards on LET'S MAKE A DEAL are provided under Official Notice based on Examiner Corbett Coburn's personal knowledge as described in the attached affidavit. In LET'S MAKE A DEAL the emcee would tempt players to swap a first prize for a chance to select an unknown second prize. The offer was sometimes made before the first prize was revealed such that the player was required to choose between a first and second unknown prize. As a result of the emcee's temptation, the game generated increased excitement for both the player and the audience. Additionally, the tempting offer served to prolong the suspense of the game. At other times, the emcee would sometimes reveal non-selected awards before or after revealing a selected award in order to satisfy the players' and audience's curiosity. Notably, displaying unselected awards also served to advertise products provided by the show's sponsors and demonstrates the value of the non-selected prizes.

Hence, LET'S MAKE A DEAL suggests a game providing an award without revealing the player's success and enabling the player to decide whether to keep the award to enhance the excitement and suspense of a game by teasing players with a chance to pick another award. The game also suggests revealing unselected awards before and after revealing a selected award to enhance a game's excitement by teasing player's curiosity with forgone opportunities. This method provides an entertaining award display, advertises desirable merchandise and proves the value of unselected prizes.

Generally, incorporating television game show themes into standalone gaming devices is known in the art. First, it benefits players by allowing those who could/would not travel to participate or prefer not to compete against others to have access to a similar game for a single person. Second, it benefits operators by allowing them to take advantage of the popularity and name recognition of games with features proven to be popular. Third, it benefits the show's owners by allowing them to collect licensing fees. Accordingly, *Yoseloff* suggests automating the features of television game shows to incorporate their themes into single-player gaming devices that are thematically consistent with the original show.

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The methods of revealing award values listed in claims 10-12 and 18, 19 are equivalent variations of the method described by LET'S MAKE A DEAL because the claimed steps employ equivalent means of revealing awards for the same purpose of enhancing a players' interest in a game.

In conclusion, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Yoseloff*, wherein a gaming device is based on the game show LET'S MAKE A DEAL, to incorporate the show's features of teasing players with the opportunity to trade an unrevealed award for another award and revealing unselected awards. The modification would enhance the entertainment offered by the device by teasing a player's curiosity of forgone opportunities, providing entertaining award display, advertising desirable merchandise and proving the value of unselected prizes.. Additionally, the modification would attract and retain a greater number of players based on the game's connection to a widely recognized and popular game theme and thereby increase the operator's revenue.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703 308 4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9302 for regular communications and 703 872 9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.



Steven Ashburn
July 30, 2002



MARK SAGER
PRIMARY EXAMINER

Examiner's Affidavit

Come now the undersigned and makes this his Examiner's Affidavit and states as follows:

I am over eighteen years of age and am competent in all respects to enter the testimony contained herein. I make this affidavit freely and I have personal knowledge of all facts averred herein.

I watched "Let's Make A Deal" prior to the year 1999. During the game show, the host would sometimes reveal to the contestant what the contestant could have won had he chosen another box, door, or curtain. On other occasions, the host would ask other members of the studio audience if they would like to have the prize in one boxes, doors, or curtains not chosen by the contestant – sometimes doing so before the contestant's prize was revealed and sometimes after the contestant's prize was revealed.

The host would often try to tempt the player to trade prizes for an unknown prize. From time to time, after the contestant chose a prize, the host would reveal one of the other prizes and give the contestant the opportunity to trade the prize he already had for the remaining unrevealed prize – again, this offer was sometimes made before the prize the contestant initially chose was revealed and sometimes after the initially chosen prize was revealed. At other times, the host would try to tempt the contestant to trade prizes before revealing any prize. Whenever the host tempted the contestant to trade prizes, the audience would become involved, shouting advice to the contestant. This greatly increased the excitement of the show for the audience and the player. It also prolonged the suspense.

I believe that the prize was revealed, at least in part to satisfy the curiosity of the contestant and the audience. If, for instance, the contestant chose door number two, and won a wrecked car, people wanted to know what the good prize actually was and where it was hidden. I believe another reason the prize was revealed was in order to advertise the merchandize that made up the prize.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

This 25th day of July, 2002



Corbett B. Coburn III
Patent Examiner